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PATENT
Docket No.: 55839US002

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

JOANNES SCHUREN, KURT ALLENBERG and
ANDREW J. CALLINAN

Serial No.: 09/693,770
Filed: October 20, 2000
For: CURABLE OFF-LOADING
FOOTWEAR AND METHODS

Group Art Unit: 3764

Examiner: M. Brown

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Date: March 20, 2006	Printed Name: <i>Nancy M. Lambert</i>

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

Dear Sir:

Appellants hereby request a Panel Review of the final rejection dated October 18, 2005 in the above-identified application. No amendments are being filed with this request. This request is being filed with a Notice of Appeal.

Status of the Claims

The pending claims 1, 3, 5-13 and 16-20 stand rejected. Claims 15 and 21 stand objected to as being dependent on a rejected base claim, but would be allowable if rewritten in independent form.

Review is requested for the following reasons:

The Examiner rejects claims 1-3, 5-8, 12, and 16-18 under 35 U.S.C. § 102(b) as anticipated by the disclosure of U.S. Pat. No. 4,888,225 to Sandvig (the '225 reference). The Examiner asserts that the '225 reference discloses in Figures 9A and

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9B “a custom footbed comprising a substrate 54, having an upper surface with contours . . . , a depression . . . and a compressible wound spacer 52 . . . attached to the upper surface of the substrate (fig. 9D).”

As discussed in Applicants' Specification on page 6, line 29 to page line 2, this invention includes a resin-impregnated foam which results in a uniform layer thickness during compression and cure. In other words, the foam is compressible such that depressions may be created to relieve pressure and pain on the foot. On the other hand, the '225 reference discloses a resin-impregnated foam block 54 used as the substrate. However, the substrate does not disclose a uniform layer thickness. The '225 reference discloses a “rigid foot orthotic shell” that is pressed onto a resin-impregnated foam block 54. The foam is compressed to conform to the bottom contours of the orthotic 52 (as opposed to the foot), while providing a flat support surface on the bottom of block 54.

Applicants amended claim 1 during prosecution to recite “wherein the substrate comprises a uniform layer thickness.” As discussed in Applicants' Specification on page 6, line 29 to page line 2, resin-impregnated foams result in a non-uniform layer thickness during compression and cure. Considering the Examiner's reference to Sandvig's resin-impregnated foam block 54 as the substrate, Sandvig '225 fails to teach a substrate with a uniform layer thickness.

Applicants have further amended claim 1 during prosecution to recite “a compressible wound spacer located within the depression on the upper surface of the substrate.” Considering the Examiner's reference to Sandvig's resin-impregnated foam block 54 as the substrate, Applicants respectfully submit that the orthotic 52 (identified by the Examiner as wound spacer 52) is not compressible. Rather, orthotic 52 is formed using an orthopedic casting tape. In Sandvig, it is the substrate 54 that is compressible, not the orthotic 52. As recited in col. 18, lines 9-17 (emphasis added):

Referring now to FIG. 9B, once orthotic 52 has been *formed*, an activated resin-impregnated block 54 within the scope of the present invention is oriented directly below the arch of foot orthotic 52. As seen in FIGS. 9C and 9D, the rigid foot orthotic shell is then *pressed down* on the activated resin-impregnated foam block 54. Again, the foam *compresses to conform* to the bottom contours of orthotic 52, while providing a flat support surface on the bottom of block 54.

Thus, the resin-impregnated foam block 54 of Sandvig '225 does not teach “a substrate with a uniform layer thickness,” nor does the rigid orthotic 52 teach “a

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compressible wound spacer." Further, Sandvig fails to teach a "wound spacer that is located within the depression on the upper surface of the substrate." Accordingly, for at least the above reasons, the Sandvig '225 reference fails to teach all elements of the claims and cannot anticipate the claims as amended.

Claim Rejection under 37 U.S.C. §103

Claims 9-13 and 19-20 are rejected under 37 U.S.C. 103(a) as being obvious over Sandvig '225 in view of Sandvig '047. The Office Action recognizes that '225 fails to disclose a contact layer attached to the upper surface of the substrate, and relies on '047 for that disclosure. For the reasons given above, adding the contact layer of '047 does not cure the deficiencies of the '225 reference.

Applicants have amended claim 12 to clarify the scope of the invention. In light of the Examiner's interpretation that the orthotic 52 and foam block 54 correspond to Applicants' wound spacer and curable substrate respectively (which Applicants' dispute as argued above), both Sandvig '225 and Sandvig '047 (alone or in combination) fail to disclose a compressible surface, or that the compressible surface supports the foam block 54; or that the foam block 54 is located between the orthotic 52 and any compressible surface.

Summary

For at least the foregoing reasons, Appellants respectfully request that the Panel review and reverse the final rejection of claims 1, 3, 5-13 and 16-20 in the above-identified application, and that Panel Decision allowing the application on the existing claims be issued.

Respectfully submitted,

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